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| 09/909,401   | 07/19/2001  | Jeffrey Scott Eisenberg | INTRA-001A          | 9907             |
| 7663   | 7590        | 12/13/2004              | EXAMINER            |                  |
| STETINA BRUNDA GARRED & BRUCKER<br>75 ENTERPRISE, SUITE 250<br>ALISO VIEJO, CA 92656 |             |                         | GARG, YOGESH C      |                  |
|  |             |                         | ART UNIT            | PAPER NUMBER     |
|  |             |                         | 3625                |                  |

DATE MAILED: 12/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/909,401

Applicant(s)

EISENBERG, JEFFREY SCOTT

Examiner

Yogesh C Garg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 12-16 are objected to because of the following informalities: The numbering of claims is not in accordance with 37 CFR 1.126. Claims 12-16 have been misnumbered. Misnumbered claims 12-16 have been renumbered 11-15 respectively. Accordingly claims 1-15 are pending for examination. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2.1. Claims 1-6, 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wallis et al. (US 2001/0051884); hereinafter referred to as Wallis in view of Cheng et al. (US Patent 6,151,643), hereinafter, referred to as Cheng.

Regarding claim 1, Wallis teaches a method of marketing a product/service of a

retailer to a customer utilizing media for use in a customer computer, the media having instructions stored thereon for facilitating establishing a customer/host electronic communications link between the customer computer and a host computer and communicating a retailer designator related to the retailer via the customer/host electronic communications link, the media having informational data stored thereon related to the product/service, the method comprising;

(a) receiving by the host computer an identification of a retailer computer by the retailer, the retailer computer having product/service data stored thereon related to the informational data, the product/service data corresponding to the product/service (see at least paragraph 0039, page 4, “ *At block 305, the host system 10, generates a vendor account 220 and a purchaser account 230 and stores each account in the database 45. This occurs as the logic of the server control application 50 causes the information transmitted into the host system 10 to be processed, thereby establishing the identities the vendor 65 and the purchaser 75 of the product. Once the vendor 65 and the purchaser 75 are identified, a vendor account 220 specific to the vendor 65 identified in the information is established. The server control application 50 processes the remainder of the information and establishes an association between the vendor 65, the purchaser 75, and the product identified in the information received by the host system. This association allows the information to be presented and maintained in the appropriate document or documents within the vendor account 220. ....* “). Note: The acts of generating a vendor account 220 at the host computer 10 and establishing vendor’s identity so as to receive messages/information about the products cover the recited limitation);

(b) establishing a customer/host electronic communications link between the customer computer and the host computer through the use of the instructions in connection with access by the customer computer of the informational data, (c)

receiving by the host computer the retailer designator from the customer computer via the customer/host electronic communications link and (d) correlating the retailer designator to the retailer computer ( see at least paragraphs 0041-042, page 4 “ At block 310, data is transmitted over a computer network to the purchaser 75. For example, this data transmission is in the form of an e-mail message. The data includes instructions for the purchaser 75 to access the host system 10. The instructions explain, for example, how the purchaser 75 can employ the host system 10 for administering the warranty covering the product. This includes an explanation of the repair initiation and tracking services provided by the host system 10, and an explanation of how the purchaser can buy extended warranty coverage or cancel existing warranty coverage for the product. The instructions may also include a purchaser-specific password required for the purchaser 75 to access the Purchaser Account 230..... “. Note : Wallis teaches establishing a customer/host communication after receiving instructions via media, that is electronic mail. As regards receiving a retail designator and correlating the same to the retailer computer , the same is included in the Purchaser account 230, see paragraph 0039. By establishing the vendor identity the vendor’s computer system is also correlated. Also see paragraph 0037, pages 3-4);

Wallis does not disclose (e) facilitating a customer/retailer electronic communications link between the customer computer and the retailer computer based upon the correlation of the retailer designator to the retailer computer for access by the customer to the product/service data. However, in the same field of endeavor, that is providing updated versions of software on line to the customers, Cheng discloses this limitation (see at least col.3, lines 13-24, “ ..... The network location provided in the software update information is specified by one or more universal resource locators (URL). Thus, the update database does not store the software updates themselves, but information that is used to access the

*software from computer systems of the original vendors. In addition, the software update information includes a format description associated with specific installation programs or actions needed to install the software update.* “. Note: downloading updated software to the customer computers from the computer systems of the original vendors reads on the recited limitation, that is facilitating communication link between a customer and a retailer enabling the computer to access the product/service data. As regards correlation of vendor designator and retailer computer system, it is already covered above.). In view of Cheng, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wallis to incorporate the feature of facilitating a customer/retailer electronic communications link between the customer computer and the retailer computer for access by the customer to the product/service data because it would enable the customers to download the updated software version on the client customer computer system via a communication link.

Regarding claims 2-3, Wallis discloses updating the identification of the retailer computer and providing electronic access to the host computer by the retailer for electronically updating the identification of the retailer computer. (see at least paragraph 0037, pages 3-4, “ *processing and storing new data in appropriate records* .....*Among the documents stored in the host system 10 are one or more vendor accounts 220.....A vendor account is a document through which a vendor 65 is provided with access to a series of additional documents containing information relevant to one or more products sold by the vendor 65.....* “. Note: Processing and storing new data includes updating the identification of retailer computer.).

Regarding claim 4, Wallis teaches electronically receiving by the host computer the identification of a retailer computer by the retailer (already covered in claims 1-3 above).

Regarding claim 5, Wallis teaches that the method of claim 1 wherein (a) further comprises identifying of a retailer page of the retailer computer, and (e) further comprises facilitating a customer/retailer electronic communications link between the customer computer and the retailer page based upon the correlation of the retailer designator to the retailer page for access by the customer to product/service data ( see at least paragraph 0029, page 3, *"....Document" as used herein, includes but is not limited to an electronic document, a web page...*, paragraph 0036, *"..... defines all web pages accessible by a user 65, 75,.....at a web site* [Note: "65" represents a vendor and his computer system 60], also see paragraphs 0048-0049). Note: Vendors maintaining www sites would include web pages. All other limitations of identifying a retailer computer and establishing an electronic link between customer and retailer is already covered in claims 1-3 above.

Regarding claim 6, Wallis teaches that the method of claim 5 wherein the media has instructions stored thereon for communicating a product/service designator related to the informational data via the customer/host electronic communications link, (a) further comprises identifying a product/service designator associated with the retailer

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page, (c) further comprises receiving by the host computer the product/service designator from the customer computer via the established customer/host electronic communications link, (d) further comprises correlating the retailer designator and the product/service designator to the retailer page, and (e) further comprises facilitating the customer/retailer electronic communications link based upon the correlation of the retailer designator and the product/service to the retailer page (see at least paragraph 0041, wherein the e-mail message, which corresponds to media, identifies the product/service in the form of warranty product to be purchased and this information is received by the host computer system. As regards correlating the retailer designator and the product/service designator to the retailer page see at least paragraph 0039 ,

*"...At block 305, the host system 10, generates a vendor account 220 and a purchaser account 230 and stores each account in the database 45. This occurs as the logic of the server control application 50 causes the information transmitted into the host system 10 to be processed, thereby establishing the identities the vendor 65 and the purchaser 75 of the product. Once the vendor 65 and the purchaser 75 are identified, a vendor account 220 specific to the vendor 65 identified in the information is established. The server control application 50 processes the remainder of the information and establishes an association between the vendor 65, the purchaser 75, and the product identified in the information received by the host system.....".* As regards facilitating the customer/retailer electronic communications link it is already covered above in claims 1-5.).

Regarding claims 10-11, Wallis teaches that the method of claim 1 wherein the customer/host electronic communications and customer/retailer electronic links are established via a computer network (See at least paragraph 0032).

2.2. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being obvious over Wallis in view of Cheng and further in view of Hanway (US Patent 6,671,726)

Regarding claims 7-9, Wallis in view of Cheng does not disclose that the media is a physically portable and interfaces with the customer computer, such as CD-ROM or a flash card. However, Hanway teaches that the media is a physically portable and interfaces with the customer computer, such as CD-ROM or a flash card(see at least col.3, lines 41-50, "*....A data storage medium 12 is used to transfer data to and from the computer system 10. Medium 12 can be a floppy disk, a hard disk cartridge, a flash card or other "fixed" memory storage device, a writable CD-ROM, or any other device which allows data to be removed from the computer system 10, moved to another location, and written with new data which can again be used by the computer system 10. Lines 14 in FIG. 1 indicate that the medium is physically transferable between the computer system 10 and the access terminal apparatus 16.* "). In view of Hanway, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wallis to incorporate the feature that the media is a physically portable and interfaces with the customer computer, such as CD-ROM or a flash card because it will allow the system and users to choose any one of the available mediums to store and transfer multi-media data from one computer to another remote computer as explicitly demonstrated in Hanway.

2.3. Claim 14 is rejected under 35 U.S.C. 103(a) as being obvious over Wallis in view of Cheng and further in view of Palmer et al. (US 2002/0091582); hereinafter referred to as Plamer.

Regarding claim 14, Wallis does not teach tracking a number of times the customer/retailer communications link is established. However, Palmer teaches this limitation (see at least paragraph 0048, page 3, "*The software tool will also integrate with other online web sites, such as E-bay, to create and build useful informational pages. For example, a product list may be generated, or product statistics or user traffic may be gathered and monitored to create a statistics builder, etc. Traffic and other statistics, such as those that **track hits on e-bay** products, and traffic generated to the web site by those products, are very useful for eStore owners who use other sites, such as e-bay, to generate traffic to their eStore. They can also track what types of online listings are most effective for them.*"). In view of Palmer, it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wallis to incorporate the feature of tracking a number of times the customer/retailer communications link is established because it will allow the system to monitor the customer's activities and create useful web pages targeted to the customer's interests so as to increase traffic for their web sites, as explicitly demonstrated in Palmer.

2.4. Claim 12-13 and 15 are rejected under 35 U.S.C. 103(a) as being obvious over Wallis in view of Cheng and further in view of Official Notice.

Regarding claims 12-13, Wallis does not disclose establishing a financial relationship between a host operator of the host computer and the retailer, wherein the

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retailer owes consideration to the host operator based upon a number of times the customer/retailer electronic communications link is established/based upon sales transactions of the product/service to the customer by the retailer. It is generally well-known to pay to service providers who help in promoting business for retailers/manufacturers by advertising their products on line as it serves the purpose of both the entities, that is retailers/manufacturers and the service providers[host computer entity). The retailers/manufacturers do not have to spend large sums of money on their own in advertising and promoting their products as there are available more competent and efficient entities who as hosts/service providers /consultants are able to provide these services in a cost effective manner. Therefore, in view of the Official Notice it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wallis to incorporate the feature of establishing a financial relationship between a host operator of the host computer and the retailer, wherein the retailer owes consideration to the host operator based upon a number of times the customer/retailer electronic communications link is established/based upon sales transactions of the product/service to the customer by the retailer because, as explained above, it will allow the retailers/manufacturers to receive professional cost effective services to advertise and promote their products to increase their revenues based upon either the customer hits the retailer web sites [the number of hits indicate the interest shown in the retailer web site] or makes purchases from the web site.

Regarding claim 15, Wallis does not disclose that the retailer maintains the host computer. The examiner takes an Official Notice as it is generally well-known to make business decisions concerning the running and maintaining of operations of departments by themselves or sub-contract to outside resources depending upon cost-effectiveness of the operations. If the outside contractors, such as host computer entity/service providers can do more effective job of promoting/advertising products than the in-house departments of the retailer/manufacture it would be advisable to pay a fee to the host computer entity/service provider to get the work done. However, if the managements observes that the fee paid is more to the host computer entity/service provider and their in-house personnel can do the same job at a lower cost they may decide to operate/maintain the operations themselves. Therefore, in view of the Official Notice it would have been obvious to one of an ordinary skill in the art at the time of the applicant's invention to have modified Wallis to incorporate the feature of retailer maintaining the host computer because, as explained above, it will be a business decision by the retailer avail the services from the host computer at a cheaper cost than by spending on an outside entity running the host computer.

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) Yamaguchi et al. (US 2002/0087334) teaches that flash cards and CD-ROMS are two of the alternatives available of many other alternatives for storing and transferring media-data (see at least paragraph 0055).

(ii) Sasaki et al. (US 2002/0077988) teaches that flash cards and CD-ROMS are two of the alternatives available of many other alternatives for storing and transferring media-data (see at least paragraph 0031) and also paying a fee to the entity that provides advertising/promotion (see at least paragraph 0056, “ ..... *The content header may include a broadcaster identifier that may be used by license manager 22 to provide a commission to the broadcaster for any broadcast that resulted in a purchase of digital content. The meta-data also may include an advertisement identifier, which may be used to monitor the effectiveness of advertisements in reaching targeted potential customers.* ”).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F(8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Yogesh C Garg

Primary Examiner

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YCG

December 2, 2004